

REMARKS

Claims 1-3 and 5-15 are pending in this Application. Claims 4 and 16 have been previously canceled without prejudice. Claims 2, 3 and 7-11 have been withdrawn for this response. In the Office Action mailed December 27, 2006, the Examiner:

- provisionally rejected Claims 1, 5, 6 and 12-15 on grounds of obviousness-type double patenting (ODP) over copending Application Publication Nos. 2004/0081827 (herein "'827 publication") and 2004/0079260 (herein "'260 publication");
- rejected Claims 1, 5, 6 and 12-15 on grounds of nonstatutory obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,572,697 (herein "Gleeson");
- rejected Claims 1, 5, 6 and 12-15 under 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,365,315 (herein "Beck") or U.S. Patent No. 4,983,550 (herein "Goetz").

Applicants respectfully address herein the basis for each of the Examiner's rejections.

Claims Rejections - Nonstatutory Type Double Patenting

Applicants respectfully point out that with regard to the provisional ODP rejection on page 2 of the Office Action, the '260 publication is the instant Application for patent. In the Office Action mailed June 14, 2006, the Examiner rejected Claims 1-3 and 5-15 under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over all claims of the '827 publication and the '063 publication. To this rejection, Applicants pointed out that when two or more co-pending applications are filed on the same day, the Examiner is "to determine which application claims the base invention and which application claims the improvement" (see MPEP 804). Upon such a determination, the rejection in the base application is withdrawn (thereby removing the requirement for filing a terminal disclaimer), and the rejection may then be filed in the application claiming the improvement. Accordingly, Applicants again respectfully request the Examiner point out such distinctions in order for Applicants to appropriately respond to the provisional rejection.

On page 2 of the Office Action, the Examiner also rejected Claims 1, 5, 6 and 12-15 on grounds of nonstatutory ODP as being unpatentable over Gleeson. For a reference to be obvious, it must still teach each and every element of the claimed invention. However, Gleeson does not suggest or disclose several elements, such as microspheres with "not less than 5.2 wt. % to about 30 wt. % calcium oxide" or "about 4 to 10 wt.% sodium oxide" or "less than about 2 wt.% potassium oxide," or "wherein the microspheres have an alkali metal oxide content of less than about 10 wt.% based on the weight of the microspheres." In addition, there is no suggestion in Gleeson that their microspheres include such features. Instead, the only explicit teaching in Gleeson is that their microspheres "are hollow ceramic microspheres commonly known as cenospheres. Cenospheres are a coal ash by-product that is typically

separated from fly ash by a floatation process where the spheres float to the surface of water from clarifiers, ponds or lakes" (Col. 9, ll. 11-15). This teaching of Gleeson's is clearly not the same or even similar to synthetic microspheres and methods of making as disclosed in the instant Application. One of ordinary skill in the art would not mistake Gleeson's cenospheres of coal ash by-products separated by a floating process with the instant Application's synthetic microspheres and considered a suitable replacement for natural cenospheres. As such, because Gleeson does not teach Applicants' invention on its whole nor each and every element of Applicants' claimed invention and because there is no suggestion or motivation to modify Gleeson's teaching in order to provide Applicants' claimed invention, Gleeson cannot be considered obvious over Applicants' claimed invention. Applicants respectfully request the ODP rejection be removed.

Claims Rejections - 35 U.S.C. § 102(a) and/or 103(b)

On page 4 of the Office Action, the Examiner rejected Claims 11, 5, 6 and 12-15 as anticipated by or, in the alternative, as being obvious over Beck or Goetz. Applicants submit that neither Beck nor Goetz anticipate Applicants' claimed invention because neither reference teaches each and every element of the claimed subject matter. For example, Beck specifically teaches microspheres that are really not aluminosilicate; the aluminum oxide content is specifically taught always to be less than 1.2 wt.% (see Examples 1 and 5) and less than 1.8 wt% when combined with iron oxide (see Example 4). In addition, Beck's very specific teachings of microspheres in the examples each have a

higher alkali metal oxide content, a higher sodium metal oxide content and a lower aluminosilicate content than Applicants' claimed invention. Beck does not provide sufficient specificity for anything more than what is provided in these specific examples. As such, Beck does not teach each and every element of Applicant's claimed invention and cannot anticipate the claims. One skilled in the art cannot extrapolate these specifically disclosed embodiments of Beck to cover Applicants' claimed invention because there is no way to readily anticipate the effect of a change within the subject matter of Beck based on Beck's own disclosure. In the field of chemistry, generally, there is also a well-known unpredictability of chemical reactions that alone are considered enough to create a reasonable doubt as to the accuracy of a particularly broad statement that may be made and is never considered to be an enabling support for more specific subject matter. In addition, Applicants' point out that the mere fact that a worker in the art can rearrange the parts of Beck to meet the terms of Applicants' claimed invention is not sufficient to support obviousness. The reference itself must provide motivation or reason for the worker in the art (without benefit of Applicants' specification) to make the necessary changes. Applicants reiterate that Beck's very specific microsphere teaching could not simply be modified or rearranged by itself or by one of ordinary skill in the art, because the Beck reference does not itself provide any motivation or reason for any modifications other than the specific teachings within Beck that are vastly different from Applicants' claimed invention. Accordingly, Beck does not teach each element of Applicants' claimed invention and there is no motivation or suggestion by the

reference or to one of ordinary skill to make anything but the examples provided by Beck. Beck starts with crushed glass and ends up with particles from crushed glass that have little aluminosilicate, a higher alkali metal oxide content and a higher sodium metal oxide content than Applicants' claimed synthetic microspheres. As such, Beck does not anticipate and is not obvious over the claims.

With regard to Goetz, this reference also does not anticipate Applicants' claimed invention because Goetz does not teach each and every element of Applicants' claims. For example, Goetz does not teach microspheres having less than about 2 wt% potassium oxide. Instead, Goetz requires 3.8 to 10 wt.% of potassium oxide (Col. 3, ll. 24-26). Goetz further teaches the R_2O_3 is B_2O_3 . When aluminosilicate is used, the content is less than Applicants' range (4.89% in Example 1 and 4.93% in Example 3). As such, Goetz does not teach each and every element of Applicant's claimed invention and cannot anticipate the claims. Goetz is also not obvious over Applicants' claimed invention because Goetz has a very specific teachings of microspheres with a high B_2O_3 content, a lower aluminosilicate content and a higher potassium oxide content than Applicants' claimed invention and, thus, explicitly teaches very different microsphere than Applicants' claimed microspheres. The very specific microsphere teaching of Goetz could not simply be modified or rearranged by itself or by one of ordinary skill in the art because the Goetz reference does not itself provide any motivation or reason for any modifications other than the specific teachings within Goetz that are vastly different from Applicants' claimed invention. One skilled in the art cannot simply

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extrapolate these specifically disclosed embodiments of Goetz to cover Applicants' claimed invention because there is no way to readily anticipate the effect of a change within the subject matter of Goetz based on Goetz's own disclosure. Accordingly, Goetz is not obvious over Applicants' claimed invention. Applicants respectfully request removal of the rejections and entry and allowance of the claims as provided herein.

CONCLUSION

Applicants respectfully submit that the Application is in condition for allowance, and pursuant to the filing of this Amendment, Applicants earnestly seek allowance of Claims 1, 5-6, and 12-15 as provided in the Listing of Claims beginning on page 3 of this paper. Should the Examiner have questions, comments, or suggestions in furtherance of the prosecution of this Application, please contact Applicants' representative at 214.999.4330. Applicants, through their representative, stand ready to conduct a telephone interview with the Examiner to review this Application if the Examiner believes that such an interview would assist in the advancement of this Application.

To the extent that any further fees are required during pendency of this Application, including petition fees, the Commissioner is hereby authorized to charge payment of any additional fees, including, without limitation, any fees under 37 C.F.R. § 1.16 or 37 C.F.R. § 1.17, to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 129843-1104. In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant any such petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account.

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This is intended to be a complete response to the Office Action mailed December 27, 2006.

Please direct all correspondence to the practitioner listed below at Customer No. 60148.

Respectfully submitted,

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Dated: March 27, 2007